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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

RIBAR, TRAVIS B

ART UNIT PAPER NUMBER

1711

DATE MAILED: 12/16/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Applicati n No.

09/998,935

Examiner

Travis B Ribar

Applicant(s)

ZHOU ET AL.

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply .

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 16-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of group 1 in Paper No. 8 is acknowledged. The traversal is on the ground(s) that the restriction is not proper. This is not found persuasive because the requirement for restriction in this case is that the product in the claims of group 1 may be used in a materially different process not encompassed by the claims in group 2. This is true in this case, as described in the prior office action.

The requirement is still deemed proper and is therefore made FINAL.

2. This application contains claims 16-33 drawn to an invention nonelected with traverse in Paper No. 8. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Claim Objections***

4. Claim 8 objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to

cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claim contains some limitations, such as, "...n-decyl acrylate..." which contains more carbons in the alkyl group than the newly amended claims allow.

***Oath/Declaration***

5. The examiner notes the presence of a proper Declaration in the present application and confirms the telephone conversation with the applicant regarding this matter made on October 28, 2002.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-9 and 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yau et al. in view of Everaerts et al.

Yau et al. discloses a high temperature resistant PSA tape made from an acrylate ester, a carboxylic acid functional monomer, and a crosslinking agent. The acrylate ester (column 5, lines 51-67) is the same acrylate ester in claims 1, 8-9, and 14-15, and the carboxylic acid functional monomer (column 6, lines 19-20) is the same as the monomer in claims 1, 7, and 15.

The applicant claims a pressure sensitive adhesive that has a specific ratio of carboxylic acid functional monomers to crosslinking agents. The amount of carboxylic acid functional monomers (see example 1) in Yau et al. is the same as those in claims 11-13. In addition, the amount of crosslinking agent in Yau et al. (column 8, lines 21-23) is also the same as the amount of crosslinking agent that the applicant shows is useful (in their examples). Since the amount of each component in Yau et al. is the same as the amount of each component in the present application, the molar ratios of the two components are also the same. Yau et al. thereby meets that part of claims 1, 4-6, and 15.

Yau et al. does not, however, teach the use of the exact crosslinker that the applicant claims in claims 1 and 15. That aspect of the invention is in Everaerts et al., which is discussed above and teaches that the claimed crosslinker is a good crosslinking agent to use in an acrylate-based PSA.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the crosslinking agent in Everaerts et al. in the PSA in Yau et al. The motivation for doing so would be that the crosslinking agent is known to be a good crosslinking agent for the composition in Yau et al. and that the substitution of one crosslinking agent for another is not outside the invention envisioned in Yau et al. Therefore it would have been obvious to combine Everaerts et al. with Yau et al. to obtain the invention as specified in claims 1-9 and 11-15.

The heat exposure properties of the adhesive, appearing in claims 2 and 3 of the present invention, are properties inherent to a given material. As such, any material

Art Unit: 1711

that fulfills the applicant's material claims fits these property claims as well. Yau et al. in view of Everaerts et al. meets the material claims set forth by the applicant, as shown above, specifically, the combination of Yau et al. and Everaerts et al. discloses the same composition as the applicant used for the same purpose (a PSA). Therefore even though the combination of Yau et al. and Everaerts et al. does not refer to the heat resistance properties of its invention, it still anticipates claims 2 and 3, especially since Yau et al. reveals the resistance of the PSA to high temperatures (column 11, lines 25-47).

8. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yau et al. in view of Everaerts et al. as applied to claim 1 above, and further in view of Peloquin et al.

The combination of Yau et al. and Everaerts et al. discloses the invention in claim 1 (discussed above), but does not include the exact crosslinking agent of claim 10. Peloquin et al., disclosed in the applicant's 1449 form (WO 97/31076), discloses that the crosslinking agent in claim 10 is used to crosslink acrylic-based PSA's. Since the structure of the crosslinking agent in claim 10 is so close to the structure disclosed by Everaerts et al., the compatibility of the references is not an issue.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the crosslinking agent in Peloquin et al. in the PSA taught by the combination of Yau et al. and Everaerts et al. The motivation for doing so would be that the crosslinking agent is known to effectively crosslink an acrylic-based PSA and further

that the structure of the crosslinking agent in Peloquin et al. is broadly encompassed by Everaerts et al. Therefore it would have been obvious to combine Peloquin et al. with Everaerts et al. and Yau et al. to obtain the invention as specified in claim 10.

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yau et al. in view of Everaerts et al. as applied to claim 1 above, and further in view of the abstracts of both JP-02178379A and JP-03281585A.

The combination of Yau et al. and Everaerts et al. discloses the invention in claim 1 (discussed above), but does not include the exact crosslinking agent of claim 10. The abstracts of both JP-02178379A and JP-03281585A disclose that the crosslinking agent in claim 10 is used to crosslink acrylic-based PSA's. Since the structure of the crosslinking agent in claim 10 is so close to the structure disclosed by Everaerts et al., the compatibility of the references is not an issue.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the crosslinking agent taught by the abstracts of both JP-02178379A and JP-03281585A in the PSA taught by the combination of Yau et al. and Everaerts et al. The motivation for doing so would be that the crosslinking agent is known to effectively crosslink an acrylic-based PSA and further that the structure of the crosslinking agent in the abstracts of both JP-02178379A and JP-03281585A is broadly encompassed by Everaerts et al. Therefore it would have been obvious to combine the teachings of the abstracts of both JP-02178379A and JP-03281585A with Yau et al. and Everaerts et al. to obtain the invention as specified in claim 10.

***Response to Arguments***

10. The applicant's amendments overcome the rejections made in the prior office action using Everaerts et al. and Oji et al. as primary references.
11. The examiner maintains the rejections made in the previous office action using Yau et al. as a primary reference, the texts of which are supplied above.
12. The applicant argues that Yau et al. does not apply to the newly amended claims because it does not contain a PSA that meets the definition of 'consisting essentially of.' The examiner respectfully disagrees and notes that the PSA in Yau et al. contains only a minor amount polymer electrolyte (column 3, line 64 to column 4, line 1) and stabilizer (column 4, lines 9-29) blended into the composition above and beyond the materials that the applicant claims in the current invention. The applicant envisions the addition of materials to the PSA (see the parts of claims 1 and 15 regarding tackifiers and plasticizers), and the examiner believes that the presence of the materials in the reference would not alter the basic and novel properties of the adhesive that the applicant is attempting to patent. Therefore, the examiner holds that Yau et al. meets the applicant's newly added limitation of, 'consisting essentially of.'

***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Klein et al. discloses an adhesive that is similar to the adhesive the applicant claims.

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Travis B Ribar whose telephone number is (703) 305-3140. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (703) 308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are (703)


Art Unit: 1711

872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Travis B Ribar  
Examiner  
Art Unit 1711

TBR  
December 12, 2002



James J. Seidleck  
Supervisory Patent Examiner  
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